

### **REMARKS**

The application has been reviewed in light of the Office Action dated May 20, 2009. Claims 1-32 are pending in this application with claims 25-32 being withdrawn from initial examination. By the present Amendment, claim 4 has been canceled and claims 1, 2, 5, 6, 16 and 24 have been amended. It is submitted that no new matter has been added and no new issues have been raised by the present Amendment.

#### **Information Disclosure Statement**

On page 2 of the May 20, 2009 Office Action, the Examiner asserted that listing of references in the specification is not a proper information disclosure statement. The Examiner indicated that references have to be submitted in a separate paper for them to be considered.

In response, applicants note the Examiner's request and will submit shortly an Information Disclosure Statement including the references listed in the specification for the Examiner's review.

#### **Claim Rejections - 35 U.S.C. §112(a)**

On pages 2 and 3 of the May 20, 2009 Office Action, the Examiner rejected claims 1-8, 21 and 23 as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regard as the invention.

The Examiner alleged that "the production" recited in claim 1 lacks antecedent basis.

In response, applicants have amended claim 1 to more clearly define the term.

The Examiner also alleged that "the mean carbon value" recited in claim 2 lacks antecedent basis.

In response, applicants maintain that the term "the mean carbon value" does have antecedent basis in claim 1.

The Examiner further alleged that the limitation "the viscosity reducing solvent" recited in claim 3 lacks antecedent basis.

In response, applicants maintain that the limitation “the viscosity reducing solvent” is not recited in claim 3, but in claim 6 instead. Applicants have amended claim 6 to be dependent on claim 5. Accordingly, this limitation now has antecedent basis in claim 5.

The Examiner yet further alleged that a limitation in claim 4 lacks antecedent basis.

In response, applicants note that claim 4 has been canceled. Therefore, this rejection is now moot.

The Examiner yet further alleged that “F” in the chemical formula recited in claim 16 is not defined.

In response, applicants submit that it was a typographic error and have amended claim 16 to recite the correct chemical formula.

The Examiner yet further alleged that the limitation “the enthalpy” recited in claim 21 lacks antecedent basis.

In response, applicants maintain that the term “enthalpy” is a common scientific term which is well understood by a person skilled in the art. This term is also described on page 22, lines 28-30 of the subject specification.

The Examiner yet further alleged that the limitation “the formation” recited in claim 23 lacks antecedent basis.

In response, applicants maintain that this limitation is not recited in claim 23, but in claim 24 instead. Applicants have amended claim 24 to more clearly define the term.

### **Double Patenting**

On pages 3 and 4 of the May 20, 2009 Office Action, the Examiner provisionally rejected claims 1-24 on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 1-19 of copending U.S. Serial No. 10/557,339.

In response, applicants note the Examiner’s provisional double patenting rejection and will

consider filing a terminal disclaimer once it is the only remaining rejection or once any of the copending applications is allowed with patentably indistinct claims.

**Rejections under 35 U.S.C. §102(a) – Claims 1-3, 6, 9 and 18-21**

On pages 4-6 of the May 20, 2009 Office Action, the Examiner rejected claims 1-3, 6, 9 and 18-21 under 35 U.S.C. §102(a) over Stark et al. (U.S. Patent Publication No. 2004/0126298).

In response, Applicants respectfully submit that the cited reference cannot be used as prior art under 35 U.S.C. §102(a) against the claims of the subject application. The subject application claims priority of PCT International Application No. PCT/CH2004/000151, filed March 15, 2004. Accordingly, the currently pending claims are entitled to a priority date of March 15, 2004.

The cited reference, U.S. Patent Publication No. 2004/0126298, was published on July 1, 2004. Therefore, the cited reference by the Examiner has a publication date after the effective filing date of the subject application. Therefore, U.S. Patent Publication No. 2004/0126298 can not be a §102(a) prior art against the subject application.

Accordingly, it is improper to reject the claims 1-3, 6, 9 and 18-21 under 35 U.S.C. §102(a) over U.S. Patent Publication No. 2004/0126298.

To the extent U.S. Patent Publication No. 2004/0126298 may qualify as art under 35 U.S.C. §102(e), applicants respectfully submit that Stark et al. do not teach every limitation of the pending claims 1-3, 6, 9 and 18-21.

Stark et al. disclosed the manufacture of metal oxides and the preparation of a mixture of metal precursors and carboxylic acids. Therefore, Stark et al. only disclosed the “cation source” of the subject invention.

Pending claims 1-3, 6, 9 and 18-21 require a step of forming a mixture of a cation source and an anion source. Pending claims 1-3, 6, 9 and 18-21 also require that the anion source contains an anionic group which is selected from phosphates, borates, silicates, sulfates, carbonates, hydroxides, fluorides and mixtures thereof. Stark et al. did not teach any anion source in its mixtures, much less an anion source containing a specific anionic group as recited in pending claims 1-3, 6, 9 and 18-21.

Therefore, Stark et al. failed to teach every limitation of pending claims 1-3, 6, 9 and 18-21.

Accordingly, applicants respectfully request the Examiner reconsider and withdraw this rejection.

**Rejections under 35 U.S.C. §103(a) – Claims 4, 5, 7, 8, 10-14 and 22**

On pages 6-8 of the May 20, 2009 Office Action, the Examiner rejected claims 4, 5, 7, 8, 10-14 and 22 under 35 U.S.C. §103(a) over U.S. Patent Publication No. 2004/0126298 and further in view of U.S. Patent Publication No. 2006/0229197.

In response, Applicants respectfully submit that neither U.S. Patent Publication No. 2004/0126298 nor U.S. Patent Publication No. 2006/0229197 can be a 35 U.S.C. §102(a), §102(b), or §102(d) prior art.

The respective assignee, U.S. filing date and publication date of the cited references are summarized in the following table:

Reference	Assignee	U.S. Filing Date	Publication Date
US 2004/0126298	Eidgenossische Technische Hochschule Zurich	6/24/2003	7/1/2004
US 2006/0229197	Eidgenossische Technische Hochschule Zurich	5/20/2003	10/12/2006

As shown in the above table, none of the references cited by the Examiner has either a publication date before the effective filing date of the current claims or a U.S. filing date of more than one year before the effective filing date of the subject application, i.e. March 15, 2004. Therefore, the cited references can not be a 35 U.S.C. §102(a), §102(b), or §102(d) prior art.

To the extent U.S. Patent Publication Nos. 2004/0126298 and 2006/0229197 may qualify as art only under 35 U.S.C. §102(e), none of them can be relied upon to make a rejection under 35 U.S.C. §103. See, e.g. 35 U.S.C. §103(c).

As further shown in the above table, all of the cited references have the same assignee, Eidgenossische Technische Hochschule Zurich, as the subject application. Pursuant to 35 U.S.C. §103(c), if a reference qualifies as prior art only under §102(e), (f) or (g), it shall not preclude patentability under 35 U.S.C. §103 if “the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of

assignment to the same person.” Because cited references may qualify only under 35 U.S.C. §102(e), and both the subject application and cited references are subject to an obligation of assignment to Eidgenossische Technische Hochschule Zurich at the time the claimed invention was made, the cited references can not be used in a rejection under 35 U.S.C. §103.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

**Rejections under 35 U.S.C. §103(a) – Claims 15-17, 23 and 24**

On pages 9 and 10 of the May 20, 2009 Office Action, the Examiner rejected claims 15-17, 23 and 24 under 35 U.S.C. §103(a) over U.S. Patent Publication No. 2004/0126298 and U.S. Patent Publication No. 2006/0229197 and further in view of Fujii et al. (U.S. Patent No. 4,659,617).

In response, as discussed in the above section relating to the rejection of claims 4, 5, 7, 8, 10-14 and 22 under 35 U.S.C. §103(a), neither U.S. Patent Publication No. 2004/0126298 nor U.S. Patent Publication No. 2006/0229197 can be used in a rejection under 35 U.S.C. §103.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

**Rejections under 35 U.S.C. §103(a) – Claims 1-24**

On pages 10 and 11 of the May 20, 2009 Office Action, the Examiner rejected claims 1-24 under 35 U.S.C. §103(a) over U.S. Patent Publication No. 2004/0126298 in view of U.S. Patent Publication No. 2006/0229197 and further in view of Fujii et al. (U.S. Patent No. 4,659,617).

In response, as discussed in the above section relating to the rejection of claims 4, 5, 7, 8, 10-14 and 22 under 35 U.S.C. §103(a), neither U.S. Patent Publication No. 2004/0126298 nor U.S. Patent Publication No. 2006/0229197 can be used in a rejection under 35 U.S.C. §103.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

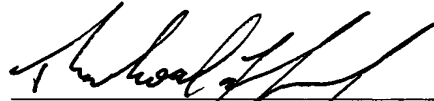
The Office is hereby authorized to charge any additional fees that may be required in connection with this amendment and to credit any overpayment to our Deposit Account No. 03-3125.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition, and the Commissioner is authorized to charge the requisite fees to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Entry of this amendment and allowance of this application are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Richard F. Jaworski', is written over a horizontal line.

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